

II. REMARKS/ARGUMENTS

These Remarks are in response to the Office Action mailed September 8, 2006.

Supervisory Examiner Hong is thanked for returning the Applicants phone call on September 14, 2006 for a brief teleconference, requested in Examiner Hun Long's absence from the USPTO until September 22, 2006. During the teleconference Supervisor Hong indicated that the finality of the July 26, 2006 office action had been withdrawn in Examiner Hun Long's office action of September 8, 2006. Supervisor Hong also indicated that he was aware that the due diligence period in question was now from 3/27/2001 to 4/10/2001 and that an accounting for such a gap was in his view required.

Claims 1, 4, 8, and 10-25 were pending in the Application prior to the outstanding Office Action. The Office Action rejected claims 1, 4, 8, and 10-25. Claim 25 has been amended. Claims 1, 4, 8, and 10-25 remain pending in the Application.

In the following discussion Stifelman will be used to designate Stifelman, et al., "The Audio Notebook, Paper and Pen Interaction with Structured Speech," SIGCHI's 01, March 31-April 4, 2001, vol. 3(1), ACM 2001, pages 182-189.

REGARDING THE DECLARATION

The Examiner stated **"there is a gap from 3/27/2001 to 4/10/2001 during the critical time to prove due diligence. Such gap of almost two weeks is not allowed without any acceptable excuses."**

REGARDING CONCEPTION

The Applicant's declaration supplied with the *reply to Office Action filed May 2, 2006* is relied upon to establish conception prior to the date of the Stifelman reference.

REGARDING DUE DILIGENCE

The Applicant directs the Examiner to affirmative act #1, the receipt of the document by the lead inventor on Tuesday March 27, 2001 (Declaration of Inventors April 13, 2006, pt # 32). After receipt the lead inventor reviewed the document, added comments and sent this 'marked up' copy of the document to the second named inventor through inter office mail.

After receipt and review of the document by the second named inventor and addition of any comments the 'marked up' copy was dispatched in the inter office mail system to the third named inventor for review. After receipt and review of the document by the third named inventor and addition of any comments the copy was dispatched in the inter office mail system to the fourth named inventor for review. After receipt and review of the document by the fourth named inventor and addition of any comments the copy was dispatched in the inter office mail system to the lead inventor. After this review by each of the inventors, the lead inventor made final changes based on the other inventor's cumulative suggestions and condensed superlative language to generate a master copy. This master copy was then mailed by the lead inventor on Tuesday, April 10, 2001 (Declaration of Inventors April 13, 2006, pt # 33) affirmative act #2. During the ten (10) business day interval in question, the four inventors reviewed and corrected the application (Declaration of Inventors April 13, 2006, pt # 33) affirmative act #3.

Considering the actual ten (10) business days in question, at least four (4) days were expended in circulating the document to the different inventors in the different locations at Fuji Xerox Palo Alto complex through inter office mail. This leaves less than six (6) days total in which the document was available for review by the four (4) different inventors with four (4) very different and demanding schedules. While the lead inventor has reviewed the claims at an earlier time point, the second, third and fourth named inventors were seeing the draft of the application for the first time. The time expended for this task, is equivalent to less than one and one half (1.5) days per inventor for reviewing the entire application including claims and then making comments and corrections.

The circumstances here are in stark contrast to the facts in Mulder, where there was a total lack of evidence of diligence to couple conception to the filing date Mulder v. Wulms, 219 USPQ 189, 193 (Fed. Cir. 1983). Here, the Applicants have submitted substantial evidence of due diligence to couple conception to the filing date. The Inventors have declared that they received and that they collectively reviewed the final draft of the application to be filed. Further, the period the Examiner is questioning in this application is significantly shorter than the one month period in Fitzgerald where the inventors "took no other steps toward reducing invention to practice ..." Fitzgerald v. Arbib and Quandt, 122 USPQ 530,

532 (CCPA 1959). The Applicants declaration can also be distinguished from the testimony in Kendall in that it supplied specific dates upon which the Examiner can rely. The Applicants supply the date the application was received and the date the application was returned to the attorneys. Kendall v. Searles, 81 USPQ 363 , 369 (CCPA 1949). The declaration also states that the application was reviewed and corrected by all four inventors. Thus the Applicants declaration can be distinguished from the circumstances in Rebstock with the inventors “[m]erely asserting diligence ...”. Rebstock v. Flouret, 191 USPQ 342, 345 (BPI 1975).

A court may take judicial notice of facts not subject to reasonable dispute. Federal Rule of Evidence 201(b). Applicants submit that the time it takes for inter office mail delivery within the Fuji Xerox complex in Palo Alto, California, where the inventors work is a suitable matter for a court of appropriate jurisdiction to take judicial notice. Further, an allowable excuse of up to 1.5 days per reviewer to review a final draft of an application is an acceptable excuse. Thus, the distribution time coupled with the time taken to review and draft comments accounts for the entire period of due diligence. Based on the specific dates, judicially noticed facts and allowable excuses there is simply no gap and therefore, the Applicant respectfully submit that due diligence couples conception with the filing date.

Thus the Applicant shows that the declaration supplied with the *reply to Office Action filed May 2, 2006* establishes the Applicant’s priority of invention over the Stifelman reference.

CLAIM OBJECTIONS

Claim 25 has been amended. The amendment is supported in the specification at least at paragraphs [0061]-[0062].

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Claims 1, 4, 11-12 and 14-24 were rejected under 35 U.S.C. '102(e) as being anticipated by Stifelman.

As discussed above, *Stifelman* does not have priority and therefore does not anticipate

the Applicants invention.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 102(e) rejections.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 8 and 25 were rejected under 35 U.S.C. '103(a) as being unpatentable over Stifelman in view of Davis et al., "Notepals: Lightweight Note Sharing by the Group, for the Group," ACM 1999, pages 338-345 (hereafter, "Davis").

As discussed above, the Applicant has shown that *Stifelman* is neither anticipatory nor prior art to the Applicants invention and as such is not available to be combined with *Davis*.

Claims 10 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stifelman in view of Davis and further in view of Mora et al. (U.S. Pat No. 6,161,113).

As discussed above, the Applicant has shown that *Stifelman* is neither anticipatory nor prior art to the Applicants invention and as such is not available to be combined with *Davis* and *Mora*.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 103(a) rejections.

III. CONCLUSION

In light of the above, it is respectfully submitted that all remaining claims, as amended in the subject patent application, should be allowable, and a Notice of Allowance is requested.

The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of the patent.

The Commissioner is authorized to charge the required fees of \$120.00 and any underpayment of fees or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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